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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Docket No: SUNMP063
)
Kapon D. CARTER) Group Art Unit: 2174
)
Application No: 09/046,784) Examiner: C. Dela Torre
)
Filed: March 23, 1998) Date: March 11, 2003
)
For: METHOD AND APPARATUS FOR)
SELECTING ATTACHMENTS)
)

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Kay Harlow

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION -- 37 CFR 192)

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Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on January 6, 2003. The Notice of Appeal was received by the USPTO on January 13, 2003 (copy of PTO received postcard with January 13, 2003 date enclosed). Therefore, the due date for this Appeal Brief without extension is March 13, 2003. This Appeal Brief is transmitted in triplicate:

This application is on behalf of:

☐ Small Entity ☒ Large Entity

Pursuant to 37 CFR 1.17(f), the fee for filing the Appeal Brief is:

☐ \$160.00 (Small Entity) ☒ \$320.00 (Large Entity)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply:

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☐ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

<u>Months</u>	<u>Large Entity</u>	<u>Small Entity</u>
<input type="checkbox"/> one	\$110.00	\$55.00
<input type="checkbox"/> two	\$400.00	\$200.00
<input type="checkbox"/> three	\$920.00	\$460.00
<input type="checkbox"/> four	\$1,440.00	\$720.00

If an additional extension of time is required, please consider this a petition therefor.

☐ An extension for __ months has already been secured and the fee paid therefor of \$ is deducted from the total fee due for the total months of extension now requested.

☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition and fee for extension of time.

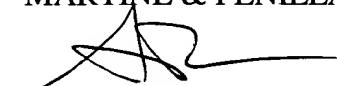
Total Fees Due:

Notice of Appeal Fee	<u>\$320.00</u>
Extension Fee (if any)	\$____.00
Total Fee Due	<u>\$320.00</u>

☒ Enclosed is Check No. 8577 in the amount of \$320.00.

☐ Charge any additional fees or credit any overpayment to Deposit Account No. 50-0850, (Order No. SUNMP063). Two copies of this transmittal are enclosed.

Respectfully submitted,
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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE CARTER

Application for Patent

Filed March 23, 1998

Application No. 09/046,784

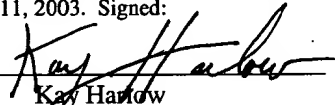
FOR:

METHOD AND APPARATUS FOR SELECTING ATTACHMENTS

APPEAL BRIEF

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Kay Harlow

MARTINE & PENILLA, LLP
Attorneys for Applicant

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TABLE OF CONTENTS

	<u>Page No.</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	1
III. STATUS OF THE CLAIMS	1
IV. STATUS OF THE AMENDMENTS	1
V. SUMMARY OF THE INVENTION	1
VI. ISSUES	4
A. Are claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?	4
B. Are claims 3, 10, 15, and 19 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?.....	4
C. Are claims 4, 8, 13, and 20 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?.....	4
VII. GROUPING OF THE CLAIMS	4
VIII. ARGUMENTS.....	4
A. The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 as required to establish a prima facie case of obviousness.....	4
B. The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 3, 10, 15, and 19 as required to establish a prima facie case of obviousness.....	11
C. The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 4, 8, 13, and 20 as required to establish a prima facie case of obviousness.....	13
D. The Yohanan reference, either alone or in combination with Borman et al., teaches away from the limitations of claims 3, 10, 15, and 19.	14

E. The Yohanan reference, either alone or in combination with Borman et al., teaches away from the limitations of claims 4, 8, 13, and 20.....	16
F. Conclusion.....	17

APPENDIX A - CLAIMS ON APPEAL

I. REAL PARTY IN INTEREST

The real party in interest is Sun Microsystems, Inc., the assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any related appeals and/or interferences.

III. STATUS OF THE CLAIMS

A total of 23 claims were presented during prosecution of this application. The Applicant appeals rejected claims 1-23.

IV. STATUS OF THE AMENDMENTS

A request for continued examination (RCE) was filed October 16, 2001, in a continued prosecution application (CPA) filed September 7, 2000. The original application was filed on March 23, 1998. All amendments have been entered, leaving rejected claims 1-23.

V. SUMMARY OF THE INVENTION

A method and apparatus for selecting attachments is described. When a sender indicates in an e-mail application or applet that an attachment is to be associated with an e-mail message, an attachment chooser window is presented. The attachment chooser window provides a browser-based graphical user interface (GUI) which allows a sender to browse data resources, such as HTML documents and associated links. An attachment mechanism is provided by which a sender can choose a currently displayed data resource for attachment in an e-mail message. In one embodiment, the attachment mechanism allows a user to select

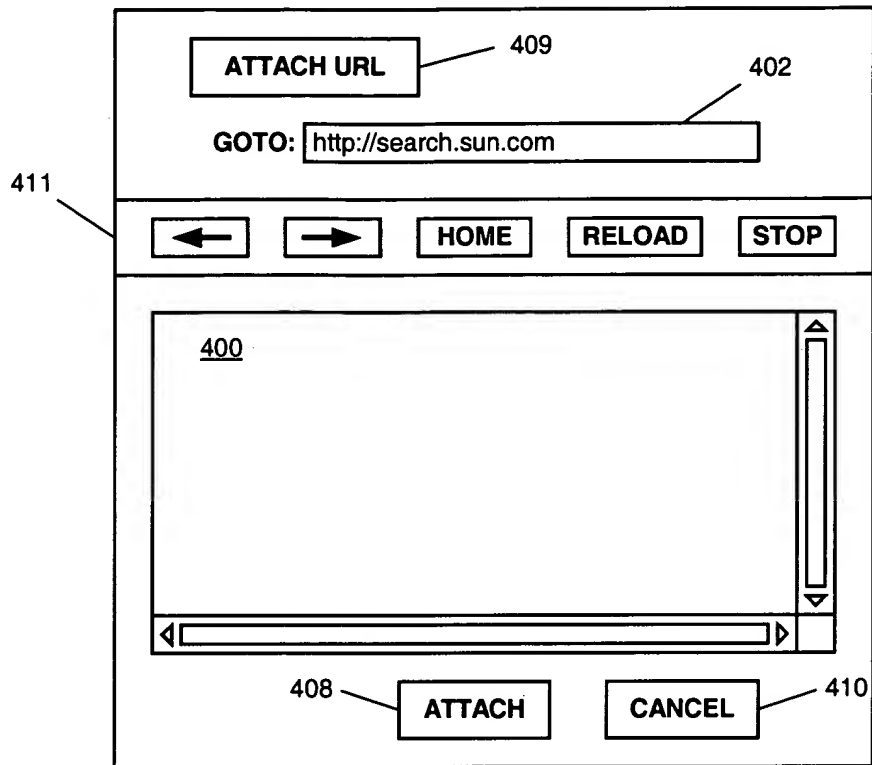
whether the attachment is retrieved and attached to an e-mail message as a resource locator (such as a URL) of the chosen data resource, or whether source data of the data resource is retrieved and attached to the e-mail message as one or more source files.

In an embodiment of the invention, an attachment chooser software component is instantiated by an e-mail application. The attachment chooser software component is configured to provide a graphical user interface (GUI) for selecting a web-based attachment. The attachment chooser GUI interface is configured as a web browser and comprises the following components: a menu component 409 configured to control how an attachment is added to an e-mail message, e.g., as a resource locator (URL) or as source data; an editable "go-to" text field component 402 configured to identify the URL of the currently viewed data resource; a toolbar component 411 providing the basic navigation controls for browsing data resources such as web pages; a browsing component (i.e., display region) 400 configured to perform parsing and rendering of data resources; and one or more button components 408 and 410 configured to receive input to attach a currently viewed data resource to an e-mail message or to cancel an attachment session.

The menu component 409 provides a mechanism by which the sender can specify whether selections within the display region 400 are to be attached as a URL or as the source data of the data resource associated with the URL. The menu component 409 is configured with selectable states, with the currently selected state indicating the form an attachment will take (i.e., the "attachment type").

The "attach" button 408, when activated, is configured to return an attachment associated with the currently displayed data resource to the e-mail application for attachment to the e-mail message being composed. The state of menu component 409, is queried, when

"attach" button 408 is activated, to determine how the attachment is to be returned to the e-mail application, e.g., as a URL or as an input stream containing the bits of the source data associated with the URL.



VI. ISSUES

The issues presented in this appeal are whether the rejections under 35 U.S.C. §103(a) of the claims under appeal are proper. The three issues therefore are as follows:

- A. Are claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?
- B. Are claims 3, 10, 15, and 19 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?
- C. Are claims 4, 8, 13, and 20 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. in view of Yohanan?

VII. GROUPING OF THE CLAIMS

Applicant proposes three groups of claims to stand or fall together. The first group includes claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 ("Group I"). The second group includes claims 3, 10, 15, and 19 ("Group II"). The third group includes claims 4, 8, 13, and 20 ("Group III"). Each group will be argued separately.

VIII. ARGUMENTS

- A. **The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 as required to establish a *prima facie* case of obviousness.**

Rejection

Applicant's claims 1-2, 5-7, 9, 11-12, 14, 16-18, and 21-23 (Group I claims) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Borman et al. ("Borman") (U.S. Patent No. 5,890,172) in view of Yohanan (U.S. Patent No. 5,737,560).

Borman Reference

Borman teaches a computer implemented method for retrieving information through a browser connected to a network and providing the information to a user. The method of Borman allows a search to be conducted in a non-linear order, whereby a searcher can jump across multiple levels at a time. In the application of the Borman method, a first file includes information such as site identifiers corresponding to file locations on the network. The first file is displayed in a browser window. The first file is also parsed by a jumper to generate a list of site identifiers contained within the first file. The list of site identifiers is stored by the jumper and displayed in a jumper window. A user is allowed to select a site identifier in the jumper window. Next the jumper directs the browser to access the file at the site corresponding to the selected site identifier and display the file in the browser window. The user is allowed to perform a drill-down search through many levels of site identifiers. At any point in the drill-down search, the user can select another site identifier parsed from the first file by making a selection in the jumper window. This allows a user to return directly to the list of site identifiers parsed from the first file without having to perform a reverse traversal of the site identifiers selected during the drill-down search.

Yohanan Reference

Yohanan teaches a computer implemented method for permitting a computer system to access a network location using a browser application by activating a desktop icon. The method includes displaying a desktop icon associated with a "jumpsite file" containing a network address corresponding to the network location. When the desktop icon is activated, a browser application or new browser window is instantiated, and the network address is passed

to the browser. The browser then accesses the network location. The desktop icons configured to direct a browser to a network location are called "jumpsites".

Summary of Group I Claims

Applicant's claim 1 recites an apparatus that includes a browsing mechanism configured to render a current data resource in a display region of a graphical user interface. The current data resource includes at least one current document. The browsing mechanism is also configured to navigate through a number of data resources. The apparatus further includes a selection mechanism configured to select a portion of the current document rendered in the display region. The selection mechanism is activated in response to a user input. The apparatus also includes an attachment mechanism configured to retrieve an attachment from the selection mechanism. The attachment represents the selected portion of the current document rendered in the display region. The attachment mechanism is also configured to attach the retrieved attachment to an e-mail message. The attachment mechanism is activated in response to a user input.

Applicant's claim 7 recites a method for selecting attachments. The method includes displaying a graphical user interface that has a browsing mechanism configured to render a current data resource and a selecting mechanism configured to select a portion of a desired data resource. The method also includes browsing through one or more data resources using the browsing mechanism. The browsing is performed to determine a desired data resource that includes at least one current document. The method further includes selecting a portion of the current document using the selecting mechanism. Additionally, the method includes retrieving an attachment from the selecting mechanism and attaching the attachment to an e-mail message. The attachment is associated with the selected portion of the current document.

Applicant's claim 12 recites a computer program product including a computer usable medium having computer readable code embodied therein. The computer readable code is configured to cause a computer to operate in general accordance with method of claim 7. In one element of claim 12, the computer readable code causes a computer to retrieve an attachment from the selecting mechanism and attach the attachment to an e-mail message.

Applicant's claim 17 recites a memory including a stored data structure. The stored data structure includes components similar to the mechanisms of claim 1. In one element of claim 17, the data structure includes an attachment component that includes a method configured to retrieve an attachment from the selecting component and attach the attachment to an e-mail message in response to a user input.

Applicant's claim 23 is similar to claim 1. Also, each of claims 2, 5-6, 9, 11, 14, 16, 18, and 21-22 depend from one of claims 1, 7, 12, 17, and 23.

Examiner's Position

The Examiner relies on Borman to teach a browsing mechanism configured to render a current data resource and navigate through a plurality of data resources. The Examiner also relies on Borman to teach an attachment mechanism configured to retrieve an attachment from the browser in response to a user event. Also with regard to the Applicant's claim 1, the Examiner states that Borman teaches that the user will be able to invoke the product from within their electronic e-mail box by double-clicking on attached files.

The Examiner states that Borman does not teach attaching the attachment to an e-mail message. The Examiner also states that Borman does not teach a selection mechanism to select a portion of a current document for attachment to an e-mail message.

The Examiner relies on Yohanan to teach selecting a portion of a current document by selecting jumpsite icons. The Examiner also relies on Yohanan to teach that jumpsite icons can be attached to e-mail messages.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to attach a portion of a current document to an e-mail message as taught by Yohanan in the invention of Borman because it allows for immediate access to a designated web site.

Applicant's Rebuttal

Borman does not teach an attachment mechanism configured to retrieve an attachment from a selection mechanism and attach the attachment to an e-mail message in response to a user event as claimed by the present invention. Contrary to the Examiner's position, Borman's teachings of a jumper window 300 (Figure 3) and a selection of a hot-link with a mouse (column 6, lines 55-60) are in no way related to an attachment mechanism or associated attachment operation. The jumper window 300 as shown in Figure 3 is taught as a display mechanism for a list of URLs associated with a network location that is actively displayed in a browser. Column 6, lines 55-60, of Borman refer to a drop-down list of parsed URLs that can be used to select, retrieve, and display the content associated with a particular URL. The Examiner erroneously states that because Borman's jumper window 300 allows a user to see all the hot-links on a given level and select a hot-link (column 6, lines 41-46), the jumper window 300 allows for retrieving an attachment from the browsing mechanism. Selecting a hot-link causes the browser to access and display a file associated with the hot-link (column 5, lines 3-10). Selecting a hot-link does not retrieve an attachment from the jumper window 300. The jumper window 300 in no way performs as an attachment mechanism. Contrary to the

Examiner's assertion, the jumper window 300 is not configured to retrieve an attachment from a selection mechanism and attach the attachment to an e-mail message in response to a user event. Therefore, Borman does not teach in any respect the use of either the jumper window 300 or the drop down list of parsed URLs as an attachment mechanism configured to retrieve an attachment and attach the attachment to an e-mail. Only hindsight afforded by the present invention combined with extrapolation of Borman's teachings would allow the jumper window 300 and drop-down list of parsed URLs to be misconstrued as a teaching of an attachment mechanism capable of performing associated attachment operations.

Yohanan does not teach a selection mechanism configured to select a portion of a current document in response to a user input. Furthermore, Yohanan does not teach an attachment mechanism configured to retrieve an attachment from a selection mechanism and attach the attachment to an e-mail message in response to a user event. The Examiner erroneously asserts that Yohanan teaches selecting a portion of a current document by selecting jumpsite icons that can be attached to e-mail messages. The reality is that Yohanan does not teach selecting a portion of a current document. Rather, Yohanan teaches selection of jumpsite icons and the attachment of jumpsite icons to an e-mail message. A jumpsite icon is a desktop icon that "jumps" the user to a designated web site or jumpsite (column 5, lines 45-47). The jumpsite icons only contain information related to a description of the jumpsite icon, the network address (e.g., URL) of the web site to be associated with the jumpsite icon, and the jumpsite icon name (column 6, lines 1-5). Column 7, lines 45-50, of Yohanan teach away from the claimed invention by stating "If the recipient of the message does not have WebJumper installed, a text file appears when they double-click the icon. This file contains the URL information for the web site associated with the jumpsite icon, but does not contain

the web page itself." In an even more clear example, column 9, lines 9-15, of Yohanan teach away from the claimed invention by stating "... the jumpsite file stores the URL but does not contain executable browser code." Thus, the jumpsite icons do not contain any source data for the file associated with the URL. Therefore, attaching a jumpsite icon to an e-mail message as taught by Yohanan does not teach attaching source data or a portion of source data from a current document (e.g., web page) to an e-mail message.

Numerous decisions recognize that an invention will not be deemed obvious when the prior art "teaches away" from the invention. See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990).

Notwithstanding the fact that neither Borman, Yohanan, nor the combination thereof, teach or suggest all the limitations of the Group I claims, there is also a lack of teaching, suggestion, or motivation in either Borman or Yohanan to combine the references to produce the Applicant's invention as claimed. Borman is concerned with solving the problem of having to traverse in reverse order through a number of sites visited in a drill-down search in order to reach the original document from which the drill-down search began. Yohanan is concerned with solving the problem of not having a convenient way to access network locations without having to open a browser and key-in the desired site's URL. The nature of the problems solved in Borman and Yohanan do not suggest a combination of their teachings to produce the Applicant's claimed invention. Additionally, the teachings of Borman and Yohanan do not provide a suggestion to combine the references to produce the Applicant's claimed invention. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves. In re Fine, 837 F.2d

1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In addition, the prior art must suggest the desirability of a modification of a prior art reference to reflect features of the claimed invention. In re Fritch, 922 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Also, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one having ordinary skill in the art, to combine the references. Additionally, the references when combined must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As discussed above, the Examiner has not established a *prima facie* case of obviousness because there is neither suggestion nor motivation, in either the references or in the knowledge of one having ordinary skill in the art at the time of the invention, to have combined the references in the manner proposed. Furthermore, the references when combined do not teach or suggest all of the claim limitations.

B. The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 3, 10, 15, and 19 as required to establish a *prima facie* case of obviousness.

Rejection

Applicant's claims 3, 10, 15, and 19 (Group II claims) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Borman in view of Yohanan.

Summary of Group II Claims

Applicant's claims 3, 10, 15, and 19 depend from independent claims 1, 7, 12, and 17, respectively. Thus, claims 3, 10, 15, and 19 by definition incorporate all of the elements and limitations of the independent claims from which they depend. Applicant's claims 3, 10, 15, and 19 introduce a limitation requiring the attachment to include source data associated with the current document.

Examiner's Position

The Examiner states the following: "Borman teaches that the attachment comprises a resource locator [claim 2] at column 7, lines 62-63, or source data [claim 3] associated with the current data resource at column 13, lines 32-38."

Applicant's Rebuttal

Column 7, lines 62-63, of Borman actually state the following: "A representative hot-link 514, is shown to contain both an URL 516 and a text portion 518." Contrary to the Examiner's inference, Borman does not identify the hot-link as an attachment to an e-mail. Rather, the subject hot-link is identified simply as being one of a plurality of hot-links listed in a search result summary. Furthermore, the hot-link is identified by Borman as containing both a URL and a text portion. Borman does not teach that the hot-link contains source data. Therefore, not only does Borman fail to teach that the hot-link is an attachment retrieved from a selection mechanism, Borman also fails to teach that the attachment includes source data associated with the current document.

To establish a *prima facie* case of obviousness, the references when combined must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As discussed above, the Examiner has not established a *prima facie* case of

obviousness because the references when combined do not teach or suggest all of the claim limitations.

C. The combination of Borman et al. in view of Yohanan fail to teach or suggest all the limitations of claims 4, 8, 13, and 20 as required to establish a *prima facie* case of obviousness.

Rejection

Applicant's claims 4, 8, 13, and 20 (Group III claims) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Borman in view of Yohanan.

Summary of Group III Claims

Applicant's claims 4, 8, 13, and 20 depend from independent claims 1, 7, 12, and 17, respectively. Thus, claims 4, 8, 13, and 20 by definition incorporate all of the elements and limitations of the independent claims from which they depend. Applicant's claims 4, 8, 13, and 20 introduce a limitation requiring the attachment mechanism to be configured to select an attachment type for the attachment.

Examiner's Position

The Examiner states the following: "Borman teaches selecting an attachment type [claim 4] at column 12, lines 56-61." Also, "as per claim 20, the first part is similar to claim 4, while the second part is taught by Borman with site window 404, at column 7, line 32, and at Figure 5A, which allows a user to select the property value by entering the site location."

Applicant's Rebuttal

Column 12, lines 56-61, of Borman actually state the following: "Similarly in another embodiment, the user can specify what types of results should be parsed (e.g., only categories). Alternatively, in another embodiment, the jumper parses all the site identifiers, but the user specifies how many or what type to display." The teachings of Borman at column

12, lines 56-61, are directed to parsing of URLs in accordance with at least one URL distinguishing characteristic. The teachings of Borman at column 12, lines 56-61 are not related in any way to the selection of an attachment type (i.e., URL versus source data representation). Therefore, the Examiner's assertion that Borman teaches selecting an attachment type is without support.

To establish a *prima facie* case of obviousness, the references when combined must teach or suggest all the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As discussed above, the Examiner has not established a *prima facie* case of obviousness because the references when combined do not teach or suggest all of the claim limitations.

D. The Yohanan reference, either alone or in combination with Borman et al., teaches away from the limitations of claims 3, 10, 15, and 19.

Rejection

Applicant's claims 3, 10, 15, and 19 (Group II claims) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Borman in view of Yohanan.

Summary of Group II Claims

Applicant's claims 3, 10, 15, and 19 depend from independent claims 1, 7, 12, and 17, respectively. Thus, claims 3, 10, 15, and 19 by definition incorporate all of the elements and limitations of the independent claims from which they depend. Applicant's claims 3, 10, 15, and 19 introduce a limitation requiring the attachment to include source data associated with the current document.

Argument

Yohanan does not teach an attachment mechanism configured to retrieve an attachment from a selection mechanism and attach the attachment to an e-mail message in

response to a user event, wherein the attachment includes source data associated with a current document. Yohanan teaches selection of jumpsite icons and the attachment of jumpsite icons to an e-mail message. A jumpsite icon is a desktop icon that "jumps" the user to a designated web site or jumpsite (column 5, lines 45-47). The jumpsite icons only contain information related to a description of the jumpsite icon, the network address (e.g., URL) of the web site to be associated with the jumpsite icon, and the jumpsite icon name (column 6, lines 1-5). Column 7, lines 45-50, of Yohanan teach away from the claimed invention by stating "If the recipient of the message does not have WebJumper installed, a text file appears when they double-click the icon. This file contains the URL information for the web site associated with the jumpsite icon, but does not contain the web page itself." In an even more clear example, column 9, lines 9-15, of Yohanan teach away from the claimed invention by stating "... the jumpsite file stores the URL but does not contain executable browser code." Thus, the jumpsite icons do not contain any source data for the file associated with the URL. Therefore, attaching a jumpsite icon to an e-mail message as taught by Yohanan does not teach attaching source data or a portion of source data from a current document (e.g., web page) to an e-mail message.

Numerous decisions recognize that an invention will not be deemed obvious when the prior art "teaches away" from the invention. See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). Further, combining references that result in an inoperative combination cannot be said to be obvious.

E. The Yohanan reference, either alone or in combination with Borman et al., teaches away from the limitations of claims 4, 8, 13, and 20.

Rejection

Applicant's claims 4, 8, 13, and 20 (Group III claims) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Borman in view of Yohanan.

Summary of Group III Claims

Applicant's claims 4, 8, 13, and 20 depend from independent claims 1, 7, 12, and 17, respectively. Thus, claims 4, 8, 13, and 20 by definition incorporate all of the elements and limitations of the independent claims from which they depend. Applicant's claims 4, 8, 13, and 20 introduce a limitation requiring the attachment mechanism to be configured to select an attachment type for the attachment.

Argument

Yohanan does not teach an attachment mechanism configured to select an attachment type for the attachment. Yohanan teaches selection of jumpsite icons and the attachment of jumpsite icons to an e-mail message. Yohanan does not teach an option for selecting an attachment type for the jumpsite icon when attached to an e-mail message. Column 9, lines 9-15, of Yohanan teaches that "... the jumpsite file stores the URL but does not contain executable browser code." Therefore, attaching to an e-mail message a jumpsite icon that can only contain a URL, as taught by Yohanan, teaches away from being able to select an attachment type.

Numerous decisions recognize that an invention will not be deemed obvious when the prior art "teaches away" from the invention. See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). Further, combining references that result in an inoperative combination cannot be said to be obvious.

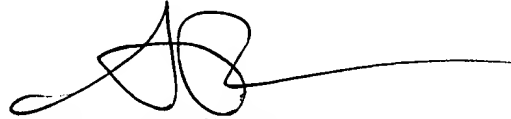
F. Conclusion

As noted above, the Applicant submits that the cited art of record fails to teach or suggest each of the claimed elements in each of the argued groups. The Applicant would also like to bring the Board's attention that during prosecution of this case the Examiner has had three opportunities (i.e., (i) after the original filing, (ii) after the CPA filing, and (iii) after the latest RCE filing) to perform a search in order to find and apply art that is more relevant to the presented claims. Specifically, the Examiner has relied upon the teachings of Borman (the primary reference) since the first Office Action on the original filing. The Applicant's therefore conclude that the Borman reference must represent what the Examiner believes to be the strongest cited art available. In view of the shortcomings of the Borman reference as discussed in the Applicant's aforementioned arguments, the Applicant submits that the presently claimed invention is patentable over the cited art.

The Applicant respectfully requests that the Board consider each group of claims separately, and consider each claim element individually with respect to the teachings of the cited art.

In sum, the Applicant submits that the rejections of the Group I claims under 35 U.S.C. §103(a), the Group II claims under 35 U.S.C. §103(a), and the Group III claims under 35 U.S.C. §103(a) are in error, and respectfully request that the Board of Appeals and Interferences reverse the Examiner's rejections of the claims on appeal.

Respectfully Submitted,
MARTINE & PENILLA, LLP

A handwritten signature in black ink, consisting of a stylized 'A' and 'P' followed by a long horizontal line.

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APPENDIX A

CLAIMS ON APPEAL

1. An apparatus comprising:

a browsing mechanism configured to render a current data resource in a display region of a graphical user interface, said current data resource comprising at least one current document, said browsing mechanism configured to navigate through a plurality of data resources;

a selection mechanism configured to select a portion of said current document in response to a user input; and

an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current document.
2. The apparatus of claim 1, wherein said attachment comprises a resource locator associated with said current document.
3. The apparatus of claim 1, wherein said attachment comprises source data associated with said current document.
4. The apparatus of claim 1, wherein said attachment mechanism is configured to select an attachment type of said attachment.

5. The apparatus of claim 1, wherein said attachment mechanism comprises a button on said graphical user interface.

6. The apparatus of claim 1, wherein said browsing mechanism is configured to navigate to a first data resource using a resource locator in a second data resource.

7. A method for selecting attachments comprising:
displaying a graphical user interface having a browsing mechanism configured to render a data resource and having a selecting mechanism configured to select a portion of a desired data resource;
browsing through one or more data resources using said browsing mechanism to determine a desired data resource, said desired data resource comprising at least one current document;
selecting said portion of said current document using said selecting mechanism; and
retrieving an attachment from said selecting mechanism and attaching said attachment to an e-mail message, said attachment associated with said portion of said current document.

8. The method of claim 7, further comprising the step of selecting a type of said attachment.

9. The method of claim 7, wherein said step of retrieving said attachment comprises retrieving a resource locator of said current document.

10. The method of claim 7, wherein said step of retrieving said attachment comprises retrieving source data associated with said current document.

11. The method of claim 7, wherein said step of browsing comprises the step of navigating a resource locator in said documents.

12. A computer program product comprising:
a computer usable medium having computer readable code embodied therein for selecting an attachment, said computer program product comprising:

computer readable code configured to cause a computer to display a graphical user interface having a browsing mechanism configured to render a data resource and having a selecting mechanism configured to select a portion of said data resource;

computer readable code configured to cause a computer to respond to user input to browse through one or more data resources using said browsing mechanism, said data resources comprising at least one current document;

computer readable code configured to cause a computer to respond to user input to select said portion of said current document using said selecting mechanism;
and

computer readable code configured to cause a computer to retrieve an attachment from said selecting mechanism and attach said attachment to an e-mail message, said attachment associated with a current document.

13. The computer program product of claim 12, further comprising computer readable code configured to cause a computer to receive user input to select a type of said attachment.

14. The computer program product of claim 12, wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve a resource locator of said current document.

15. The computer program product of claim 12, wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve source data associated with said current document.

16. The computer program product of claim 12, wherein said computer readable code configured to cause a computer to respond to user input to browse comprises computer readable code configured to cause a computer to navigate a resource locator in said documents.

17. A memory configured to store data for access by a computer system, comprising:

a data structure stored in said memory and associated with a graphical user interface, said data structure comprising:

a browsing component comprising:

one or more methods configured to render a current data resource, said current data resource comprising at least one current document;

one or more navigation methods configured to navigate between a plurality of data resources;

one or more navigation components configured to invoke said one or more navigation methods of said browsing component in response to user input;

one or more selecting components configured to select a portion of said current document in response to a user input; and

an attachment component comprising a method configured to retrieve an attachment from said selecting component and attach said attachment to an e-mail message in response to a user input, said attachment associated with said current document.

18. The memory of claim 17, wherein said attachment comprises a resource locator of said current document.

19. The memory of claim 17, wherein said attachment comprises source data associated with said current document.

20. The memory of claim 17, wherein said data structure further comprises:
a property which determines a type of said attachment; and
a selection method configured to allow a user to select a value of said property.

21. The memory of claim 17, wherein said one or more navigation methods are configured to navigate a resource locator in a data resource in response to a user input.

22. The memory of claim 17, wherein said browsing component further comprises:
a stack configured to contain resource locators of navigated data resources; and
one or more methods configured to browse said navigated data resources by stepping forward and backward within said stack.

23. An apparatus comprising:
a browsing means for rendering a current data resource in a display region of a graphical user interface, said current data resource comprising at least one current document, said browsing means for navigating through a plurality of data resources;
means for selecting a portion of said current document in response to user input; and
means for retrieving an attachment from said selecting means and attaching said attachment to an e-mail message in response to a user event, said attachment associated with said current document.